



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,147	02/07/2002	Tomi Hakkarainen	4208-4027	1454
27123 7590 05/02/2008 MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101				
EXAMINER				
DINH, MINH				
ART UNIT		PAPER NUMBER		
2132				
NOTIFICATION DATE		DELIVERY MODE		
05/02/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com

Shopkins@Morganfinnegan.com

jmedina@Morganfinnegan.com

### Office Action Summary

**Application No.**

10/072,147

**Applicant(s)**

HAKKARAINEN ET AL.

**Examiner**

MINH DINH

**Art Unit**

2132

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20, 21, 23-36 and 39-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18, 20, 21, 23-36 and 39-41 is/are allowed.
- 6) ☒ Claim(s) 42-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the RCE/amendment filed 01/18/08. New claims 42-78 have been added.

***Response to Arguments***

2. Applicant's arguments filed 01/18/08 have been fully considered but they are not persuasive. Applicant states that the new claims 42-78 are apparatus counterparts to allowed method claims 1-18, 20-21, 23-36 and 39-41, includes all of the elements of the allowed claims, and, therefore, are allowable for the same reasons (page 18). Claims 42-63 and 76-78 are directed to an apparatus comprising a service provider configured to perform certain functions. Similarly, claims 64-75 are directed to an apparatus comprising a client configured to perform certain functions. Although the functions recited in claims 42-78 corresponds to the allowed method claims 1-18, 20-21, 23-36 and 39-41, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, i.e., apparatus claims cover what a device *is*, not what a device *does* (MPEP § 2114).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 42-78 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. (US 4,484,027). Lee discloses a subscription satellite television (SSTV) system for providing satellite TV service to subscribers (fig. 1).

With respect to claims 42-63 and 76-78, Lee specifically discloses an apparatus comprising a service provider, i.e., an SSTV transmitter for providing satellite TV service (fig. 1; col. 3, lines 17-53). Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP § 2114). Claims 42-63 and 76-78 are directed to an apparatus comprising a service provider configured to transmit and receive messages. Therefore, the claimed apparatus is interpreted to be a piece of hardware. However, since none of the limitations of the claims are recited structurally, Lee's SSTV transmitter, which is a hardware device, reads on the claimed apparatus.

With respect to claims 64-75, Lee specifically discloses an apparatus comprising a client, i.e., an SSTV subscriber receiver for receiving satellite

Art Unit: 2132

TV service (fig. 1; col. 3, line 54 – col. 4, line 10). Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP § 2114). Claims 64-75 are directed to an apparatus comprising a client configured to transmit and receive messages. Therefore, the claimed apparatus is interpreted to be a piece of hardware. However, since none of the limitations of the claims are recited structurally, Lee's SSTV subscriber receiver, which is a hardware device, reads on the claimed apparatus.

***Allowable Subject Matter***

5. Claims 1-18, 20-21, 23-36 and 39-41 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH DINH whose telephone number is (571)272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2132

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Minh Dinh/  
Examiner, Art Unit 2132

04/26/08